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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,821	02/19/2002	Yasuyuki Suzuki	2002-0206A	2849
513	7590	01/19/2007	EXAMINER	
WENDEROTH, LIND & PONACK, L.L.P.			PRYOR, ALTON NATHANIEL	
2033 K STREET N. W.			ART UNIT	
SUITE 800			PAPER NUMBER	
WASHINGTON, DC 20006-1021			1616	
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE		DELIVERY MODE	
3 MONTHS	01/19/2007		PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/049,821	SUZUKI ET AL.	
	<b>Examiner</b>	Art Unit	
	Alton N. Pryor	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 October 2006.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 7,20,21,33,39,40,42,43 and 47-49 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 7 and 20 is/are allowed.
- 6) Claim(s) 21,33,39,40,42,43,48 and 49 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

Applicant's arguments filed 10/29/06 with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

Claims 21,33,39,40,42,43 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a percutaneous absorption preparation comprising (S)-N-[2-(1,6,7,8-tetrahydro-2H-indeno-[5,4-b]furan-8yl)ethyl]acetamide (A = furan; X = CH<sub>2</sub>, Y = C) or (S)-N-[2-(1,6,7,8-tetrahydro-2H-indeno-[5,4-b]furan-8yl)ethyl]propionamide (A = furan; X = CH<sub>2</sub>, Y = C), does not reasonably provide enablement for a percutaneous absorption preparation comprising compounds of instant formula disclosed in claims 21,33,39,40,42,43 other than (S)-N-[2-(1,6,7,8-tetrahydro-2H-indeno-[5,4-b]furan-8yl)ethyl]propionamide (A = oxazole, etc.; X = NR<sub>4</sub> or O; Y = CH). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make / use the invention commensurate in scope with these claims. The compounds provided by the formula in claims 21,33,39,40,42,43 differ in chemical functionality and polarity as well as other chemical and physical properties. Because of this the structures encompassed in the claims may differ in activity. In fact depending upon the chemical functionality possessed by the structure an antagonistic effect could possibly result.

Claims 39,40,42,43,48,49 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treating sleep awake rhythm disorders and somnipathy using a preparation comprising (S)-N-[2-(1,6,7,8-tetrahydro-

2H-indeno-[5,4-b]furan-8yl)ethyl]acetamide (A = furan; X = CH<sub>2</sub>, Y = C) or (S)-N-[2-(1,6,7,8-tetrahydro-2H-indeno-[5,4-b]furan-8yl)ethyl]propionamide (A = furan; X = CH<sub>2</sub>, Y = C), does not reasonably provide enablement for treating biological rhythm disorders using a preparation comprising compounds of instant formula disclosed in claims 21,33 other than (S)-N-[2-(1,6,7,8-tetrahydro-2H-indeno-[5,4-b]furan-8yl)ethyl]propionamide (A = oxazole, etc.; X = NR<sub>4</sub> or O; Y = CH). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make / use the invention commensurate in scope with these claims. Biological rhythm disorder is broad term not disclosed in the specification. However, the specification does support the treatment of sleep-awake rhythm disorders and somnipathy.

Claims 39,40,42,43,48,49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not use the phrase biological rhythm disorders, and therefore the specification does not provide examples of biological rhythm disorders.

***Claim Objection / Allowable Subject Matter***

Claim 47 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 7 and 20 are allowable. The prior art does not teach or suggest an invention comprising (S)-N-[2-(1,6,7,8-tetrahydro-2H-

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indeno-[5,4-b]furan-8yl)ethyl]acetamide (A = furan; X = CH<sub>2</sub>, Y = C) or (S)-N-[2-(1,6,7,8-tetrahydro-2H-indeno-[5,4-b]furan-8yl)ethyl]propionamide (A = furan; X = CH<sub>2</sub>, Y = C) plus lauric diethanolamide.

***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Alton Pryor  
Primary Examiner  
AU 1616